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EXAMINER

NGUYEN, CUONG H

ART UNIT PAPER NUMBER

3625

DATE MAILED: 05/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/490,495

Applicant(s)

BLUMENAU, TREVOR

Examiner

CUONG H. NGUYEN

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 242-291 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 242-291 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/20/03 & 3/26/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is the answer to the communication received on 1/16/2004 (the RCE), which paper has been placed of record in the file.

2. Claims **242-291** are pending in this application; claims 292-312 have been canceled by "the Response to the Official Action dated July 16, 2003".

Priority

3. This application is a continuation of a US Pat. 6,108,637 (SN. 08/707,279) filed on 9/03/1996.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims **242, 248** is still rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Per. claim 248: A claimed function of "performing analysis" is unclear for claimed language because "analysis" covers many different meanings, and there is inherency in claim for "analyzing"/"using" data (in other word, this task MUST be done and no need to claim this feature); (in another word, the applicant MUST specifically point out what kind of

analysis). Therefore, instead of narrowing further, this claim fails to "particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention"; furthermore, does the applicant claim "a remote site" as a component of his system? Please note that the applicant claims "a system" (i.e., physical structural components), therefore if there any, "action" of a claimed component may not be a limitation of that claim; rather, it is an intent of use of that component.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 242-291 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Curran et al. (UK Patent GB 2250112A).

6. Re. to Claim 242: This is a very broad **system** claim for generating monitoring information about a display of content, some claimed information are intent of use OR are non-functional descriptive material that do not require in order to making up PHYSICAL COMPONENTS of a SYSTEM claim. In

the version of 1/16/2004, the amended version of claim 242 is merely contain amendment of components' functionalities, those are not contribute in any structural configuration of this SYSTEM claim (again, any "action" of a claimed component may not be a limitation of that claim; rather, it is an intent of use of that component; a file with embedded instructions is old and well-known, or claiming an action "associated with the content file" is an intent of use; a site having a file, said site executes an instruction when said file is accessed is also old and well-known).

It is rejected under 35 U.S.C. § 103(a) as being unpatentable over Curran et al. (UK Patent GB 2250112A).

Curran et al. teach a capture device for monitoring of what is display on a target computer, comprising:

a provider site, wherein the content has embedded an instruction to cause generation of monitoring information about the display of the content (see Curran et al., Fig.1 and pg.3 lines 11-14); the examiner submits that this feature of a content provider site is old and well-known (e.g., at the USPTO, a CPU at a group printer station has been used to receive/display instructions/content for a viewer to see what content (sending remotely from different connecting CPU of the examiners) is in queue; (e.g., please see also previously cited US Pat. of **Shoff** et al. for an obvious situation);

a site for displaying the content, wherein the display of the content on the content display site causes the execution of an embedded instruction (see Curran et al., Fig.1 and pg.3 lines 10-21); and a remote site adapted to receive the generated monitoring information (Curran et al. teach a means/step/instructions for monitoring a display/a position/a change in time of an image on a display screen (of a content/object characteristic) (see Curran et al., pp. 4:9-12, 5:3-8, 17-23); (as an old example, at USPTO a central server would do similar remote controlling/monitoring features (please see also previously cited Davis et al., US Pat. 5,796,951 - Fig.1), wherein the content/object (computer codes) is received from a different location (e.g., from an examiner CPU or from a central server for monitoring/controlling tasks).

The examiner submits that receiving computer codes from a different locations have been done using the Internet/Intranet (e.g., at the USPTO, a CPU at a group printer station has been used to receive/display instructions/content for a viewer to see what content (sending remotely from different connecting CPU of the examiners) is in queue.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to implement Curran et al. 's system in order to derive

claimed limitations because Curran et al. provide analogous features in monitoring a display of object in a computer network.

7. Re. to Claim 243: The rationales and reference for rejection of claim 242 are incorporated.

Artisans recognizes that "computer cookies" obviously including an embedded instruction which is part of a set of instructions that are embedded in a cookie's content to cause generation of monitoring information about the display of the content (note: "cookies" are pieces of information that are placed on an individual 's computer hard drive to enable the individual to more easily communicate and interact with a specific Web site (e.g., a central server). Information of a user's activity would be used to facilitate and enhance with a Web site by a cookie. The examiner also submits that there is nothing new about claiming "instructions are located in a content file", and "...and that cause generation of the monitoring information about the display of the content" merely an intent of use of a component in that claimed system.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to implement Curran et al. 's system in order to suggest this claim's limitation because Curran et al. provide analogous

features in monitoring a display of object in a computer network.

8. Re. to Claim 244: The rationales and reference for rejection of claim 242 are incorporated.

It is directed to "a system" wherein that system contains an instruction links to a set of instructions that reside external to the content.

The examiner submits that receiving computer codes from a different locations have been done using the Internet/Intranet (e.g., at the USPTO, a CPU at a group printer station has been used to receive/display instructions/content for a viewer to see what content (sending remotely from different connecting CPU of the examiners) is in queue; these received codes would be external to provided contents. The examiner also submits that there is nothing new about claiming "a link to external instructions/file..."

Artisans would recognize that monitoring through browsing by a cookies (which contains "an instruction links to a set of instructions that reside external to the content") have been done on the Internet/Intranet before this pending invention.

9. Re. to Claim 245: It is directed to a system, wherein the generated information indicates that a content was displayed.

The references and rationales for 35 USC 103(a) rejection of claim 242 are incorporated.

The examiner submits that receiving computer codes from a different locations have been done using the Internet/Intranet (e.g., at the USPTO, a CPU at a group printer station has been used to receive/display instructions/content for a viewer to see what content (sending remotely from different connecting CPU of the examiners) is in queue; a generated information on a group printer CPU/(remote examiner CPU) would acknowledge about "a content was displayed/printed out).

Artisans would recognize that a displayed text/symbol would have meanings that a content was displayed; this or other "visible" means would acknowledge a user that something is done.

10. Re. to Claim 246: It is directed to "a system" claim, wherein the remote site is the content provider site.

The references and rationales for 35 USC 103(a) rejection of claim 242 are incorporated.

The examiner submits that a remote site is a content provider site have been well-known with Internet/Intranet/LAN/WAN networks (e.g., for testing purpose, content provider site sends information to itself) and it is recognized that this is a designer's option (at the USPTO, a CPU at a group printer station has been used to

receive/display instructions/content for a viewer to see what content (sending remotely from different connecting CPU of the examiners) is in queue).

11. Re. to Claim 247: It is directed to "a system" claim, wherein the generated information about the display of the content is stored on the remote site.

The references and rationales for 35 USC 103(a) rejection of claim 242 are incorporated.

Artisans would recognize that generated information is stored on a different site (e.g., a remote site) have been old and well-known because information/data would be stored anywhere in a network having a storage medium.

12. Re. to Claim 248: It is directed to "a system" claim, wherein the remote site performs analysis on monitoring information of the content.

The references and rationales for 35 USC 103(a) rejection of claim 247 are incorporated.

Artisans would recognize that a remote site having a CPU would do analyses for obtained data (e.g., a group printer at USPTO having a CPU that would monitor queuing information of patent's hardcopies; and to a computer world, there would be virtually real-time information, hence claiming remotely would not make it no obvious); furthermore, a computer "cookies"/token has been known to do this feature (e.g., "an analysis" here can be "displaying

coordinates of objects" which have been done by AutoCad/Microsim software; including monitoring a duration with respect to an object (unchanged position) on screen is obvious (e.g., using Pspice to draw a curve with discrete digital voltage levels (0 volt or 5 volts), a duration of "0 volt" or "low" levels would be seen on a displayed curve).

13. Re. to Claim 249: It is directed to "a system" claim, wherein the content is provided by a content provider with an assigned account number, and wherein the generated monitoring information about the display of the content contains the account number of the content provider.

The references and rationales for 35 USC 103(a) rejection of claim 242 are incorporated.

In an analogous example of USPTO's group printer, there are identification of each examiner's hardcopy with time, date, name of the owner are printed for each item. Therefore, it is analogous features as claimed. The examiner also submits that there is nothing new about claiming "... a file is from a provider having an account number ...,",

14. Re. to Claim 250: It is directed to "a system" claim, wherein the generated monitoring information about the display of the content includes a time stamp.

The references and rationales for 35 USC 103(a) rejection of claim 242 are incorporated. In an analogous

example of USPTO's group printer, there are identification of each examiner's hardcopy with time, date of the owner are printed for each item. Therefore, it is analogous features as claimed.

15. Re. to Claim 251: It is directed to "a system" claim, wherein the generated monitoring information about the display of the content includes identifying information about the content display site.

The references and rationales for 35 USC 103(a) rejection of claim 242 are incorporated.

Artisans would recognize that "identifying information" in a content would be obvious to "monitoring information"/"analyzing information" as above claim 248. Therefore, similar rationales and references for a rejection of claim 248 are applied.

16. Re. to Claim 252: It is directed to "a system" claim, wherein the generated monitoring information about the display of the content includes demographic information.

The references and rationales for 35 USC 103(a) rejection of claim 242 are incorporated.

In an analogous example of USPTO's group printer, there is an "identification" of this group printer's location. Please note that claiming a **SYSTEM** does not require a limitation of "the generated monitoring information about the

display of content include identifying information about the content display site" ; in other words, the above so-called limitation is merely non-functional descriptive material. Therefore, it is an analogous feature of "displaying demographic" as claimed that is capable of doing by USPTO's group printer.

17. Re. to Claim 264: It is directed to "a system" claim, wherein the computer readable medium is resident on a content provider site.

The references and rationales for 35 USC 103(a) rejection of claim 263 are incorporated.

In an analogous example of USPTO's group printer, there are computer readable mediums on provider sites (e.g., examiner/central server 's CPUs), (furthermore, the computer's components are known to be separable or integrated - see *In re Murray*, 19 CCPA 739, 53 F.2d 541, 11 USPQ 155; *In re Zabel et al.*, 38 CCPA 832, 186 F.2d 735, 88 USPQ 367.

This claim is similar to claim 247. Artisans would recognize that generated information could be stored on a different site (e.g., a remote site) has been old and well-known because information/data would be stored anywhere in a network having a storage medium.

18. Re. to Claim 277: It is rejected under 35 U.S.C. § 103(a) as being unpatentable over Curran et al. (UK Patent GB 2250112A).

The references and rationales for 35 USC 103(a) rejection of claim 275 are incorporated.

The examiner submits that Curran et al. obviously suggest that data/content can be provided by a data/content display site (see Curran et al., Fig.1 and pg.3 lines 11-14); the examiner submits that this feature of "a content is provided by the content display site/(a CPU set)" is old (e.g., (e.g., at the USPTO, a CPU at a group printer station has been used to receive/display instructions/content for a viewer to see what content (sending remotely from different connecting CPU of the examiners) is in queue; (another example in Capps, or **Shoff** et al.);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to use **Curran** et al. 's system in order to derive this claim's limitation because Curran et al. provide features in monitoring a display of object in a computer network.

19. Re. to Claim 286: It is rejected under 35 U.S.C.

§ 103(a) as being unpatentable over Curran et al. (UK Patent GB 2250112A).

The references and rationales for 35 USC 103(a) rejection of claim 284 are incorporated.

The examiner submits that Curran et al. did using/analyzing stored data (see Curran et al., the abstract, and page 1 lines 6-18). Artisans recognize that

"computer cookies" obviously including an embedded instruction which is part of a set of instructions that are embedded in a cookie's content to cause generation of monitoring information about the display of the content (note: "cookies" are pieces of information that are placed on an individual's computer hard drive to enable the individual to more easily communicate and interact with a specific Web site (e.g., a central server). Information/(stored data) of a user's activity would be used to facilitate and enhance with a Web site by a cookie.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to use Curran et al.'s system in order to derive this claim's limitation because Curran et al. provide features in monitoring a display of object in a computer network.

20. Re. To claim 275: The examiner submits that this claim's limitations are analogous to claim 242's limitations although it is directed to a method claim. It is obvious with similar rationales & references for 35 USC 103(a) rejection of claim 242.

The examiner also submits that above claim's limitations are so broad that they read-on many computer applications involving graphic displays and a cursor besides previous Office Action cited art; since a computer microprocessor and a basic software program obviously

register any cursor movement, its current position, and depending on a specific software application, data locations/position would be processed if necessary (may be stored and displayed thereafter). These limitations are fundamental and many applications have been used (e.g., Autocad, Pspice of Microsim .etc.)

22. Claims 253, 263, 275-276, 284, 287: The examiner submits that these claims' limitations are similar/analogous to claim 242's limitations whether they are a system, a computer-readable medium, or a method claim, they are obvious with similar rationales & references for 35 USC 103(a) rejection of claim 242 (please note that in claim 276, "is provided" or "is received" is generally an act of communications by similar interpretations).

23. Claims 254, 267, 278, 290: The examiner submits that these claims' limitations are similar/analogous to claim 243's limitations whether they are a system, or a method claim, they are obvious with similar rationales & references for 35 USC 103(a) rejection of claim 243.

24. Claims 255, 268, 279, 291: The examiner submits that these claims' limitations are similar/analogous to claim 244's limitations whether they are a system, or a computer-readable medium, they are obvious with similar rationales & references for 35 USC 103(a) rejection of claim 244.

25. Claims 256, 265, 285, 288: The examiner submits that these claims' limitations are similar/analogous to claim 246's limitations whether they are a system, a computer-readable medium, or a method claim, they are obvious with similar rationales & references for 35 USC 103(a) rejection of claim 246.

26. Claims 258, 270: The examiner submits that these claims' limitations are similar/analogous to claim 248's limitations whether they are a system, a computer-readable medium, or a method claim, they are obvious with similar rationales & references for 35 USC 103(a) rejection of claim 248.

27. Claims 257, 269: The examiner submits that these claims' limitations are similar/analogous to claim 247's limitations whether they are a system, a computer-readable medium, or a method claim, they are obvious with similar rationales & references for 35 USC 103(a) rejection of claim 247.

28. Claims 259, 271, 280: The examiner submits that these claims' limitations are similar/analogous to claim 249's limitations whether they are a system, a computer-readable medium, or a method claim, they are obvious with similar rationales & references for 35 USC 103(a) rejection of claim 249.

29. Claims 260, 272, 281: The examiner submits that these claims' limitations are similar/analogous to claim 250's limitations whether they are a system, a computer-readable medium, or a method claim, they are obvious with similar rationales & references for 35 USC 103(a) rejection of claim 250.

30. Claims 261, 273, 282: The examiner submits that these claims' limitations are similar/analogous to claim 251's limitations whether they are a system, a computer-readable medium, or a method claim, they are obvious with similar rationales & references for 35 USC 103(a) rejection of claim 251.

31. Claims 262, 274, 283: The examiner submits that these claims' limitations are similar/analogous to claim 252's limitations whether they are a system, a computer-readable medium, or a method claim, they are obvious with similar rationales & references for 35 USC 103(a) rejection of claim 252.

32. Claims 266, 289: The examiner submits that these claims' limitations are similar/analogous to claim 264's limitations whether they are a system, a computer-readable medium, or a method claim, they are obvious with similar rationales & references for 35 USC 103(a) rejection of claim 264.

Conclusion

33. Claims **242-291** are not patentable.

34. These attached references are considered pertinent to applicant's disclosure.

- **Curran** et al. (UK Pat. GB 2250112A), Computer testing capture device, 05/27/1992.

- **Gabel** et al., The better to see you with - get your windows video up to speed with these graphics accelerators, Windows Magazine, 1995, n60, pg.260 (from Dialog® File 647, acc. No. 01055060).

- From Dialog® File 647, acc. No. 00588369, Synchro/resolver board supports six channels, Electronic Engineering Times, 4/15/1991, n 637, 85.

- **Shibata** et al., (US Pat. 5,835,923 - 11/10/1998), Contents information transmitting/viewing system and method therefor.

- **Pan**, (US Pat. 5,926,168 -- 7/20/1999), Remote pointers for interactive televisions.

- **Tsai**, (US Pat. 5,495,581 - 2/27/1996), Method and apparatus for linking a document with associated reference information using pattern matching.

- **Capps** (US Pat. 5,634,100 - 5/27/1997), System and method for event parameter interdependence and adjustment with pen input.

- Halliday, FastCAD offers speed, 3-D rendering features, InfoWorld, v13n49, pp.98-105, 12/09/1991.

- **Halliday**, Product Comparison: High-End CAD, InfoWorld, v13n16, pp.55-75, 4/22/1991.
- **Lubow**, An engineer's guide to AutoCAD, Industrial Engineering, v19n8, pp.ESC18-ESC20, 8/1987.
- **Parks et al.**, New workstation from SunRiver Corp. Offers highest CAD performance at affordable price, Business Wire, s1 p1, 6/11/1990.
- **McGrath**, The tail-less mouse: is innovative mouse missing more than just a tail?, Computer Graphics World, v11, p117(2), 10/1988.
- **Lombardi**, Windows Word Processors: InfoWorld tests the tools and features in six of the high-end graphical products, InfoWorld, v14n6, pp.78-96, 2/10/1992.
- **35. Remark:**
 - The amended claimed languages are still obvious with cited references in previous Office Action.
 - In Practice and procedure in Patent and Trademark Office
 - Prosecution -- Rules and rules practice (§ 110.0905) from Patent and Trademark Office, "... during ex parte examination, is not precluded from relying upon hearsay evidence in making rejections, since applicant is free to investigate any hearsay assertions relied upon by examiner, have right to introduce rebuttal evidence, and, if they wish to cross-examine authors of written hearsay assertions, can file civil action pursuant to 35 USC 145."

36. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose number is 703-305-4553. The examiner can normally be reached on 7am-3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, JEFFREY A. SMITH can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687 or 703-746-5572.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

Cuong H. Nguyen

CUONG H. NGUYEN
Primary Examiner
Art Unit 3625

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